



THE UNITED STATES PATENT AND TRADEMARK OFFICE

L. H. Hume Jr.
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ES.

Applicant : Naveen N. Anand, et al.
Appl'n. No. : 09/007,093
Filed : January 14, 1998
Title : CHIMERIC ANTIBODIES FOR DELIVERY OF ANTIGENS
TO SELECTED CELLS OF THE IMMUNE SYSTEM
Grp./A.U. : 1644
Examiner : Mary Tung
Docket No. : 1038-765 MIS:jb
Date : April 23, 2002

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The Commissioner of Patents
and Trademarks,
Box Amendment
Washington, D.C. 20231,
U.S.A.

AMENDMENT

Sir:

This Communication is in response to the Office Action of December
21, 2001.

Petition is hereby made under the provisions of 37 CFR 1.136(a) for an
extension of two months of the period for response to the Office Action. The
prescribed fee is enclosed.

The Examiner considered the oath or declaration to be defective and
that a new oath or declaration is required identifying this application by application
number and filing date. This document is enclosed.

The Examiner rejected claims 5 to 11, 27 and 28 under 35 USC 103(a)
as being unpatentable over Barber 4,950,480 or 5,194,254 in view of Baier et al or
Baier et al alone, for the reasons elaborated in paragraph 18 of the Office Action of
January 6, 2000.

In response to the Office Action of January 6, 2000, the applicants submitted a Declaration under 32 CFR 1.131 with respect to the citability of Baier et al as prior art with an Amendment after Final Action submitted June 29, 2000. In an Office Action of July 17, 2001, the Examiner withdrew rejections which involved the use of Baier et al "in light of the declaration filed under 37 CFR 1.131".

There was a further prior art rejection raised in the Office Action of July 17, 2001, which did not involve the Baier et al reference and this rejection was overcome by deleting certain of the claims and amending others. A rejection under 35 USC 112, second paragraph, was also removed by amendment. In this regard, it is noted that the Office Action of December 21, 2001 does not repeat the rejections.

However, the Examiner now reinstates the rejection made in the Office Action of January 6, 2000 involving use of the Baier et al reference indicating that;

"The Declaration filed July 3, 2000 under 37 CFR 1.131 has been reconsidered and is ineffective to overcome the cited references. The evidence is insufficient to establish a reduction to practice of the invention in this country or a NAFTA or WTO member country prior to the effective date of the cited references."

In this regard, the Examiner raised three issues:

(a) "... said declaration does not disclose the country wherein the experiments disclosed were performed"

With respect thereto, it is noted that all Declarants are resident in Canada and the Assignee is in Canada. It is logical, therefore, that the experiments were performed in Canada, a NAFTA and WTO country.

In any event, a substitute Declaration under 37 CFR 1.131 is enclosed. Paragraph 1 of the previous Declaration has been amended to recite specifically that the experiments were carried out in Canada.

(b) "The declaration indicates that the disclosed experiments were performed prior to 4/1995. However, the last two pages of the declaration disclose experiments performed 6/1995."

With respect to these two specific pages, this is discussed in paragraph 7 of the enclosed substitute Declaration under 37 CFR 1.131. As stated therein:

“ The first page refers to work done June 15, 1995 and a second page to work done June 15, 1995. These pages refer to a 'Book #2 preparation' and a 'peptide Boost for Group #3'. These pages report work performed after April 1995 but are not concerned with data reported in this patent application.” (emphasis added)

Accordingly, these pages in no manner compromise the statements made in paragraphs 2 to 5 of the Declaration, all of which are supported by the laboratory notebook pages appended to the Declaration.

In reviewing the pages of the exhibit, further pages of one of the notebooks were found to be dated May 15, 1995. Thus pages 53 and 54 are also referred to in paragraph 7 of the enclosed Declaration under 37 CFR 1.131. As noted therein, the data on page 53 presented is from November 1994 while page 54 simply contains conclusions and no new data.

(c) “The experiments disclosed in said declaration were performed by non-inventors (numerous pages signed with a signature that appears to be ‘J. Remar’ and another signature does not appear to be that of an inventor). Applicant needs to address the role of the aforementioned individuals in the claimed invention.”

In the substitute Declaration under 37 CFR 1.131, the role of the respective individuals is explained in paragraph 7. The “J. Remar” to which the Examiner refers is actually J. Remani, who worked under the direction of the inventor Naveen N. Anand, who also signed the pages from notebook 1029.

The pages from notebook 1111 are all signed by Judith E. Caterini, an inventor, with the exception of one page, signed by Jason Broderick, a technician working under the direction of Judith E. Caterini. The pages from notebook 1157 were signed by the same Jason Broderick. Judith E. Caterini signed many of these pages.

Having regard to the above and the enclosed substitute Declaration under 37 CFR 1.131, it is submitted that the substitute Declaration under 37 CFR 1.171 does not suffer from the defects perceived by the Examiner as existing with respect to that filed July 3, 2000 and that the enclosed substitute Declaration is sufficient to establish a reduction in practice in a NAFTA and WTO country prior to the effective date of the cited reference, namely April 1995.

Having regard thereto, it is submitted that the rejections of :

- claims 5 to 11, 27 and 28 under 35 USC 103(a) as being unpatentable over Barber (USP 4,950,480) in view of Baier et al;

- claims 5 to 11, 27 and 28 under 35 USC 103(a) as being unpatentable over Barber (USP 5,194,254) in view of Baier et al; and

- claims 5 to 11, 27 and 28 under 35 USC 103(a) as being unpatentable over Baier et al

should be withdrawn.

It is believed that this application is now in condition for allowance and early and favourable consideration and allowance are respectfully solicited.

Respectfully submitted,



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